

REMARKS

Applicant has carefully reviewed the Office Action mailed February 1, 2011 (hereinafter “Office Action”), and respectfully requests reconsideration of the subject application, particularly in view of the following remarks.

Status of the Claims

Claims 11–18, 31, 32, 34, 35, 37–44, and 50–56 were previously pending. Claims 1–10, 33, 33, and 36 were previously cancelled. Claims 19–30 and 45–49 were previously withdrawn. No claims are added or cancelled herein. Accordingly, claims 11–18, 31, 32, 34, 35, 37–44, and 50–56 remain pending.

Objection to the Specification

The Specification was objected to as failing to provide proper antecedent basis for the claimed subject matter. For the reasons stated below in the discussion of the rejection under 35 U.S.C. § 112, first paragraph, Applicant submits that the Specification provides proper antecedent basis for the claimed subject matter, and therefore respectfully requests that the objection be withdrawn.

Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 11–18, 31, 32, 34–44, and 50–56 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Patent Office opined that these claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicant respectfully traverses.

In particular, the Patent Office asserts: “[t]here is no disclosure in specification that provides support for input being inputted by user to identify and/or selecting desired location identifier” (Office Action, page 3). Based on this assertion, it appears that the Patent Office’s rejection relates to the following limitation in Applicant’s claim 11, and corresponding limitations in the other independent claims of the subject application: “*receiving, at the first device, user input which identifies at least one desired location identifier from the at least one*

location identifier received from the one or more second devices in response to the signal” (emphasis added).

Applicant respectfully disagrees that the subject matter recited in claim 11 is not supported by the subject application, and in fact submits that the subject application explicitly supports the subject matter relating to user input that identifies a desired location identifier. In particular, paragraph 0124 of the subject application discloses:

Alternatively, when a user enters a place with a new device, he can search for other devices by broadcasting on the network (whether wired or wireless), as shown in block 51. The other devices will return a location ID for the location or realm of which they are a part, as shown in block 52. The user can then select a desired one of the locations and enter the correct password for that location, as shown in block 53. Once this is done, then all of the devices in that realm will show up regardless of whether they are local or remote, as shown in block 54. The user is then free to do whatever the user wants to do with the other devices, if the security is set up to allow other users to control the other devices. For example, the user may play a song through another device or download a song therefrom. (Emphasis added).

Moreover, Applicant draws the Patent Office’s attention to element 53 of Figure 5, which discloses “USER SELECTS A LOCATION AND ENTERS THE PASSWORD FOR THAT LOCATION.” When a disclosure describes a claimed invention in a manner that permits one skilled in the art to reasonably conclude that the inventor possessed the claimed invention, the written description requirement is satisfied (MPEP § 2163). Applicant submits that either of these two disclosures in the subject application would convey to one skilled in the art that Applicant was in possession of the claimed invention, because each of these disclosures suggests that the user can select a location via a location identifier. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

Rejection Under 35 U.S.C. § 103(a) – Goldberg and Baba

Claims 11–18, 31, 32, 34–44, and 50–56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2005/0160270 A1 to Goldberg et al. (hereinafter “Goldberg”) and U.S. Patent Application Publication No. 2006/0168264 A1 to Baba et al. (hereinafter “Baba”). Applicant respectfully traverses.

The subject application was filed on May 5, 2004. Baba is a U.S. Patent Application Publication of an international (PCT) application (PCT No.: PCT/JP04/02903, hereinafter “the ’903 International Application”), and has a U.S. publication date of July 27, 2006, subsequent to the filing date of the subject application, and an international filing date of March 5, 2004. Thus, Baba is only prior art to the subject application if the international filing date may be treated as a U.S. filing date for purposes of 35 U.S.C. § 102(e). In this instance, however, the international filing date may not be treated as a U.S. filing date for purposes of § 102(e); thus, Baba is not prior art to the subject application. In particular, MPEP § 2136.03(II)(B) states:

(B) If the international application was filed on or after November 29, 2000, but did **not** designate the United States or was **not** published in English under PCT Article 21(2), do **not** treat the international filing date as a U.S. filing date. In this situation, do **not** apply the reference as of its international filing date, its date of completion of the 35 U.S.C. 371(c)(1), (2) and (4) requirements, or any earlier filing date to which such an international application claims benefit or priority. The reference may be applied under 35 U.S.C. 102(a) or (b) as of its publication date, or 35 U.S.C. 102(e) as of any later U.S. filing date of an application that properly claimed the benefit of the international application (if applicable).

The ’903 International Application was filed on March 5, 2004 in the Japanese language, and was published on September 23, 2004 as WO/2004/081801 in the Japanese language, as evidenced by the bibliographic information for WO/2004/081801 as reflected by the WIPO website on April 23, 2011 (see Appendix A). Thus, the international filing date is not a U.S. filing date, and Baba may only be applied as prior art under 35 U.S.C. 102(a) or 102(b) as of its publication date. Because the publication date of Baba is subsequent to the filing date of the subject application, Baba is not prior art to the subject application.

Applicant further directs the Patent Office’s attention to MPEP § 706.02(f)(1), “Examination Guidelines for Applying References Under 35 U.S.C. 102(e),” Example 5, which appears to Applicant to be an analogous situation, wherein a U.S. Patent Application Publication of an international application filed after November 29, 2000 that was not published in the English language has no 35 U.S.C. § 102(e) date.

Since Baba is not prior art to the subject application, and because the Patent Office concedes that Goldberg fails to disclose certain features recited in Applicant’s claims 11, 31, 41, and 50, Applicant submits that such claims are allowable over the cited references, and respectfully requests that the rejection be withdrawn.

Claims 12–18 and 56 depend directly or indirectly from claim 11, and should therefore be allowable as depending from an allowable independent claim. Claims 32, 34, 35, 37–40, 54, and 55 depend directly or indirectly from claim 31, and should therefore be allowable as depending from an allowable independent claim. Claim 36 has been cancelled. Claims 42–44 depend directly or indirectly from claim 41, and should therefore be allowable as depending from an allowable independent claim. Claims 51–53 depend directly or indirectly from claim 50, and should therefore be allowable as depending from an allowable independent claim.

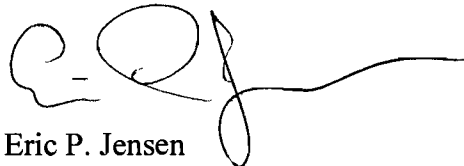
Conclusion

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

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APPENDIX A

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Search result: 1 of 1

(WO/2004/081801) INFORMATION PROCESSING DEVICE, INFORMATION PROCESSING METHOD, AND COMPUTER PROGRAM

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Title: (EN) INFORMATION PROCESSING DEVICE, INFORMATION PROCESSING METHOD, AND COMPUTER PROGRAM
 (JA) 情報処理装置、および情報処理方法、並びにコンピュータ・プログラム

Abstract: (EN) There are provided a device and a method capable of effectively acquiring information on a server connected to an internal network by a client connected to an external network. An information processing device as an application gateway connected to a boundary between the external network and the internal network executes server information acquisition processing of the connected server via the internal network on the condition that a request for acquiring information on the server connected to the internal network is received from a client connected to the external network, creates a device list according to the acquired server information, and transmits it to the client via the external network. With this configuration, the client connected to the external network can effectively acquire information on the server connected to the internal network.
 (JA) 外部ネットワークに接続されたクライアントによる内部ネットワーク接続サーバの効率的な取得装置を提供する。外部ネットワークおよび内部ネットワークの境界に接続されたアプリケーション・ゲートウェイとしての情報処理装置が、内部ネットワークに接続されたサーバ情報の取得処理を内部ネットワーク接続クライアントから受得したことを条件として、内部ネットワークを介した接続サーバのサーバ情報取得処理を実行し、取得したサーバ情報に基づいてデバイスリストを作成し、外部ネットワークを介してクライアントに送信する構成とした。本構成により、外部ネットワークに接続されたクライアントによる内部ネットワーク接続サーバの取得処理が効率的に行うことができる。

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